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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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G. Stanley
11-12-02

IN RE APPLICATION OF :

Seiichi MORI : GROUP ART UNIT: 2814

SERIAL NO: 09/876,019 :

FILED: June 8, 2001 : EXAMINER: Hoai V. PHAM

FOR: SEMICONDUCTOR MEMORY INTEGRATED CIRCUIT AND ITS MANUFACTURING METHOD :



RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the restriction requirement of September 6, 2002, Applicant elects, with traverse, Group I and Species 1. Claims 1-6 read on Species 1, with claims 1-5 believed to be generic.

The proper criteria for restriction between distinct inventions are provided in MPEP §803. The criteria are (1) the inventions must be independent or distinct as claimed and (2) there must be a *serious* burden on the examiner if restriction is not required. Regarding the second criterion, if the search and examination of an entire application can be made without a serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions (MPEP §803 (emphasis ours)).

Although the Office Action has identified separate classifications, making a prima face case of a serious burden, it is respectfully submitted that there is no serious burden in searching and examining the entire application. Using electronic searching, a search may be made of a large number of, or possibly all, classes and subclasses without any additional

effort. As patents and other publications in this art often contain descriptions of both process and the product made using the process, information as to both process and product is likely to be found in the same publication, simplifying and streamlining the search and examination process.

Also, the search areas have commonality. Class 257, subclass 315 is indented under subclass 314 which is in turn indented under subclass 288. The search notes for subclass 288 specifically refer to class 438, subclasses 197+, covering subclass 201 in which the method claims are classified. There does not appear to be a serious search burden, especially in view of this commonality in the search areas.

Also, no reasons are given why the species are patentably distinct, or why there would be a serious search burden to search and examine all species. Without any such basis in the record, the election requirement should be withdrawn and all species examined. The Applicants do not admit that the species are not patentably distinct, rather it is the burden of the PTO to establish distinctness and has not done so. Moreover, a reasonable number of species may be examined in one application (37 CFR §1.146), and the pending claims are directed to a reasonable number of species.

It is respectfully submitted that examination on the merits of all claims is in order.

Respectfully submitted,

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